

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-17 are presently active in this case. The present Amendment amends Claims 1, 5-6, 12-13, and 17 without introducing any new matter or raising new issues.

The outstanding Office Action rejected Claims 1, 5-6, 12-13 and 17 under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1-17 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Stefik et al.* (U.S. Patent No. 5,629,980, hereinafter "*Stefik*") in view of *Erickson* (U.S. Patent No. 5,765,152), in further view of Applicants' allegedly admitted prior art (hereinafter "*APA*").

In response to the rejection of Claims 1, 5-6, 12-13, and 17 under 35 U.S.C. § 112, second paragraph, Claims 1, 5-6, 12-13, and 17 are amended to correct the insufficiency of antecedent basis. Since these changes are merely formal in nature, they are not believed to raise a question of new matter. Accordingly, Applicants respectfully request reconsideration of the rejection of Claims 1, 5-6, 12-13, and 17.

In response to the rejection of Claims 1-17 under 35 U.S.C. § 103(a) over, *Stefik*, *Erickson*, and *APA*, Applicants respectfully traverse the rejection, and request reconsideration thereof, as next discussed.

Briefly recapitulating, Claim 1 relates to a method of managing copyrighted work data to be transmitted from a personal computer coupled to a first communication network to a server coupled to a second communication network. The method includes, *inter alia*, the steps of: detecting at the gateway whether copyrighted work data in communication data ***has been transmitted from the personal computer which is intended to be supplied to the server***; determining whether a user has performed a copyright licensing process for copyrighted work data in favor of a

copyright owner of the copyrighted work data; prohibiting the communication data from being uploaded to the server depending upon a determined result obtained by the step of determining.

Turning now to the applied references, *Stefik* describes a system for use and distribution of digital works (*Stefik*, Abstract, ll. 1-3). In *Stefik*, the copyright owner attaches usage rights to that work, and the works are subsequently uploaded to a repository (*Id.*, Fig. 1, step 102). After works that are copyright-protectable are uploaded to the repository, access to these works can either be denied or granted (*Id.* Fig. 1, steps 105-107, and col. 7, ll. 23-37).

However, *Stefik* fails to teach or suggest a step of detecting at the gateway whether copyrighted work data **in communication data has been transmitted from the personal computer which is intended to be supplied to the server**. As clearly shown in *Stefik* with reference to Figs. 1 and 18, the copyright protected data is already at the repository, and *Stefik* merely determines access right upon request by a user from said repository. *Stefik* clearly explains for example at col. 31, ll. 13-37, that prior to initiating a user transaction, the user needs to get his right to a transaction by obtaining an authorization certificate (*Id.*, col. 31, ll. 16-22, Fig. 18, step 1801). After having a certificate, the user may make a request to get copyright-protected data (*Id.*, col. 31, ll. 23-26, Fig. 18, step 1803) at *Stefik*'s repository. As shown in *Stefik*, "[i]f the digital work has not been granted the right corresponding to the request, the transaction terminates, step 1805" (*Stefik*, at col. 31, ll. 26-30). As clearly shown in Figs. 1 and 18 of *Stefik*, there is no detecting at the gateway whether copyrighted work data in communication data has been transmitted from the personal computer, since in *Stefik*, the copyright work data is already uploaded to the repository, and subsequently access rights are checked. The outstanding Office

Action seems to read the teachings of *Stefik* overly broad, since the cited passages of *Stefik* clearly do not support the assertions of the Office Action.

In addition, the cited passages of *Erickson* fail to remedy the deficiencies of *Stefik*, even if *arguendo* we assume the combination is a proper one. In *Erickson*, the registration and authorization server 94 allows the user to access data upon authorization, and therefore is similar to the teachings of *Stefik* (or example *Erickson*, at col. 18, ll. 25-48). Therefore, *Erickson* also fail to detect at the gateway whether copyrighted work data **in communication data has been transmitted from the personal computer which is intended to be supplied to the server.**

Since the remaining independent Claims 5, 6, 12, 13 and 17 recite a similar or somewhat similar features, the rejections of the other independent claims, and all associated dependent claims, are also believed to be overcome. In view of the above, Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection, and request reconsideration thereof.

Applicants also respectfully submit that the applied references, *Stefik* and *Erickson*, taken in any proper combination, fail to teach or suggest the features of the dependent claims.

For example, dependent Claim 2 recites features regarding notifying the copyright owner that a user has not performed the copyright licensing process. In both *Stefik* and *Erickson*, **every user** has to perform a copyright licensing process at the server for the copyrighted works (See *Stefik*, Fig. 1, steps 104 and 105, Fig. 18, at least step 1804, and see *Erickson*, Fig. 5, reference numeral 78, Fig. 6, reference numeral 94). In addition, in both references *Stefik* and *Erickson*, even assuming the combination is proper, in the cited

passages there is no notification of the owner of the copyright-protected data.

In addition, Applicants also traverse the outstanding Office Action's contention that the term "when" invokes optional language (Office Action, pp. 7-8, ll. 17-20), since "when" is not an optional term. For support of this assertion, the Office Action refers to the case In re Johnston, 77 USPQ2d 1788 (C.A.F.C. 2006). However, the Office Action contentions do not follow the rationale of the holding of the Johnston case. In Johnston, the C.A.F.C. ruled that multiple claim elements after the recitation "may" did not narrow the scope of the claim. Id. at 1790. The rejected claim language was found *inter alia* in Johnston's Claim 3, with the language "further including that said wall **may be smooth, corrugated, or profiled** with increased dimensional proportions as pipe size is increased" (emphasis added). Id. Accordingly, as of Johnston's Claim 3, the wall may optionally be smooth, corrugated, or profiled.

However, Applicants' Claims 2-3, there is no such "optional" language of multiple elements following the indefinite expression "may." Applicants' Claims 2 and 3 merely recite the conditional term "when," reciting structural limitations that the copyrighted work managing method steps will perform. The methods of Claims 2-4 must therefore be capable of performing the steps regarding notification, or prompting the user, etc. Such conditional language is neither indefinite nor optional, as erroneously asserted by the outstanding Office Action. In view of the above discussion, Applicants request reconsideration of dependent Claim 2.

With respect to dependent Claim 4. Applicants' Claim 4 recites, *inter alia*:

when the determined result of the determining step represents that the user has not performed the

copyright licensing process for the copyrighted work data, *program data for causing the copyrighted work data to be prohibited from being transmitted is transmitted to the client.*

Claim 4, portions omitted, emphasis added. As explained in a non-limiting embodiment in Applicants' specification, page 23, line 7, to page 24, line 12, a warning mail that is send to a user who may infringe a copyright can also include a program that is automatically executed so as to prevent the file that may infringe the copyright from being transmitted. In another example, the program that it sent to the user may be a browser-executable software. These examples are provided for explanation purposes only, and are not intended to limit the scope of dependent Claim 4.

The outstanding Office Action rejects the Claim 4 features based on purported admitted prior art of Applicants' Specification (See Office Action, p. 4, ll. 21-24). Applicants respectfully disagree with such assertion. Applicants' background discussion of the invention is provided from p. 1, l. 10, to p. 3, l. 13. At p. 3, ll. 2-4, the background discussion states "the copyright owner may directly attack a program of a user who performs such an illegal action." Attacking a program of a user by a copyright owner, as shown in Applicants' background discussion, does not read on the transmission of a program to the client, for causing the copyrighted work data to be prohibited from being transmitted, as required by dependent Claim 4.

Another passage of Applicants' background information provides "the copyright owner may hack the server" (See Specification, p. 2, l. 27). This passage also does not read on the features of dependent Claim 4, since in Applicants' Claim 4 a program is sent the individual user, not the server. As further explained in Applicants' specification at page 3, ll. 7-

13, "even if the server is hacked or the user is attacked, since there are a large number of users, the program cannot be thoroughly solved." In addition, nowhere in Applicants' specification Applicants' admitted that the passages from p. 1, l. 10, to p. 3, l. 13 are prior art information.

In light of the above discussion, Applicants respectfully traverse of dependent Claim 4, a request reconsideration thereof.

In response to the outstanding Office Action to request a written record whether 35 U.S.C. § 112, sixth paragraph should be evoked for Claims 5, 12 and 17, having claim elements with the language "means," Applicants respectfully submit that evocation of the 35 U.S.C. § 112, sixth paragraph, is **not** desired. Accordingly, Applicants respectfully submit that these claimed elements shall not be limited to the respective examples as shown in Applicants' specification.

The present Amendment is submitted in accordance with the provisions of 37 C.F.R. § 1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome outstanding rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103(a), the present amendment places the application in better form for consideration on appeal. It is therefore respectfully requested that 37 C.F.R. § 1.116 be liberally construed, and that the present amendment be entered.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' representative at (908) 654-5000

in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By N. Schibli
Nikolaus P. Schibli
Patent Agent
Registration No.: 56,994.
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicants

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